Regarding the written description rejection, it is stated in the Office Action that

> "It remains the Examiner's position that this disclosure, while describing SEQ ID NO:1, provides an inadequate description of sequences that are at least 90% identical to the variable region of UCHT-1 or antibodies about 90% as effective as UCHT-1 for binding human CD3."

It is further stated in the Office Action that:

> "It is the Examiner's position that the specification provides one skilled in the art no more than a method by which said skilled artisan might test any particular antibody to see if it might be encompassed by the instant claims, i.e., the specification provides only a method of trial-and-error. A method of trial-and-error is an insufficient substitute for an actual description of the claimed invention. Accordingly, it remains the Examiner's position that the specification insufficiently describes the antibodies encompassed by the instant claims."

The Examiner's attention is directed to "Written Description" requirement, 66 Fed. Reg. 1099 (January 5, 2001) ("Guidelines"); "Synopsis of Application of Written Description Guidelines ("Application of Guidelines"), available at http://www.uspto.gov/web/patents/guides.htm; and Enzo Biohem Inc. v. Gen-Probe Inc., 63 USPQ2d 1609 (Fed. Cir., 2002).

In the Enzo case, the CAFC cites the Guidelines and adopts the PTO's standards for determining compliance with the written description requirement where a functional characteristic is coupled with a disclosed correlation between that function and a structure that is sufficiently known or disclosed (Enzo at 1613). It is Applicants' position that the Enzo case is controlling for the present situation. The Examiner has acknowledged that the specification teaches a specific sequence (a "structure"). What the Examiner refers to as a "trial-and-error" method, is what the CAFC refers to as a functional description (see Enzo at 1616 "Such hybridization to disclosed organisms may meet the PTO's Guidelines stating that functional claiming is permissible when the claimed material hybridizes to a disclosed substrate."). Further in Enzo at 1615, the CAFC points to Example 9 of the Application of Guidelines with favor. In the analysis of Example 9 of the Application of Guidelines, it is stated on page 36:

> "A review of the full content of the specification indicates that the essential feature of the claimed invention is the isolated nucleic acid that hybridizes to SEQ ID NO: 1 under highly stringent conditions and encodes a protein with a specific function. The art indicates that hybridization techniques using a known DNA as a probe under highly stringent conditions were conventional in the art at the time of filing.

> The claim is drawn to a genus of nucleic acids all of which must hybridize with SEQ ID NO: 1 and must encode a protein with a specific activity. ...
>
> There is a single species disclosed (a molecule consisting of SEQ ID NO: 1) that is within the scope of the claimed genus.
>
> There is actual reduction to practice of the disclosed species.
>
> Now turning to the genus analysis, a person of skill in the art would not expect substantial variation among species encompassed within the scope of the claims because the highly stringent hybridization conditions set forth in the claim yield structurally similar DNAs. Thus, a representative number of species is disclosed, since highly stringent hybridization conditions in combination with the coding function of DNA and the level of skill and knowledge in the art are adequate to determine that applicant was in possession of the claim invention.
>
> **Conclusion:** The claimed invention is adequately described."

The facts of the present application are analogous to Example 9 of the Application of Guidelines. Applicants Claim 51 provides a specific sequence (species) coupled with functional limitations to describe a particular genus. Therefore, Applicant's specification provides a sufficient written description of the invention as defined in Claims 51-54 to comply with the requirements of 35 U.S.C. §112, first paragraph.

In the second paragraph, on page 3, of the Office Action, the Examiner's comments appear to be directed at Claim 50. Claim 50 was not rejected under grounds for lack of sufficient written description (other than the "new matter" rejection which will be addressed hereinafter). Nevertheless, if it was the Examiner's intention to also reject Claim 50 under this ground, Applicants' above remarks are equally applicable to Claim 50.

Claims 50-51 stand rejected under 35 U.S.C. §112, first paragraph, for lacking enablement.

The Office Action again states that the specification provides only a "trial-and-error" method to support Applicant's genus Claims 50-51.

As pointed out above, what the Examiner describes as a "trial-and-error" method is described by the CAFC as a functional description. It is submitted that Applicants' functional

limitations coupled with specific sequence information (as is done in Claims 50-51) are sufficient to enable a skilled artisan to practice the invention as claimed.

Claim 50 further stands rejected under 35 U.S.C. §112, first paragraph, for lacking sufficient written description which is described as and a new matter rejection. The Examiner objects to the amendment (to overcome a previous rejection) adding the phrase "the complement".

The test for sufficiency of support is whether the disclosure of the application reasonably conveys to the skilled artisan that the inventor had possession of the claimed subject matter. However, it is well settled that it is not necessary that the claimed subject matter be described in *ipsis verbis* to satisfy the written description requirement of 35 U.S.C. § 112 (see, for example, Purdue Pharma L.P. v. Faulding Inc.,56 USPQ2d 1481 (Fed. Cir. 2000)). Furthermore, explicit support is not required, inherent support is sufficient (see, for example, Standard Oil Co. v. Montedison, S.p.A., 206 USPQ 676 (D. Del. 1980), *aff'd*, 212 USPQ 327 (3d Cir. 1981), *cert. denied*, 456 U.S. 915 (1982)).

On Page 38 of the specification, the last clause of the second paragraph states: "... as well as complementary strands of the foregoing nucleic acids".

The third paragraph on Page 38 describes the polynucleotides of at least 300 bases "which hybridizes to a polynucleotide which encodes a polypeptide of the invention".

Clearly, from Applicant's specification and the relationship between polynucleotides and their complements as is well-known in the art, Applicants were in possession of the subject matter of Claim 50 upon filing of the application.

Claims 35-54 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,103,235, in view of Kreitman et al. (1995) and Krietman et al. (1994).

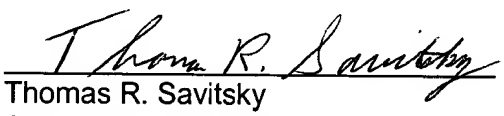
It is stated that the Office Action that Applicants previously pointed out that *a priori*, one could not predict the effectiveness of a given PE-Tac immunotoxin on a given cell population by knowing the activity of a given DT-Tac immunotoxin on that cell population and, thus, one skilled in the art having the prior art before him could not *a priori* reasonably predict the effectiveness for a particular use of an anti-CD3-PE immunotoxin with the knowledge that an anti-CD3-DT based immunotoxin is effective for that use.

The Examiner contends that because applicants are claiming a product, not a method, that the previously presented arguments are irrelevant. It is respectfully pointed out that this is manifestively not the case. As far back as the seminal case of *In re* Papesch, 137 USPQ 43 (CCPA 1963), the courts have recognized that it is an error of law to fail to take into consideration the biological or pharmaceutical property of a claimed composition of matter.

While assuming, *arguendo*, that Applicants' claimed invention may be "obvious to try" or "obvious to experiment", it is well-established that these are not the standards for obviousness under 35 U.S.C. §103 (see, e.g., *In re* Mercier, 185 USPQ 774 (CCPA 1975) and *In re* Dow Chemical Co., 5 USPQ2d 1529 (Fed. Cir. 1988)). The test for obviousness is not whether or not it would have been obvious to test Applicant's immunotoxins; but rather, whether or not it would be obvious that Applicants' immunotoxins would be successful. Because of the variability of immunotoxins as demonstrated in the cited art, it would not be obvious that Applicants' invention would be successful.

It is respectfully submitted that Applicants' specification and claims are in proper form. It is respectfully requested that the application be reconsidered, that the rejection under 35 U.S.C. §112 and §103(a) be withdrawn and that pending Claims 35-54 be passed to allowance.

Respectfully submitted,



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